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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,117	01/04/2002	Steven Ausnit	769-222 Div.2	1073
29540	7590	09/11/2007		
DAY PITNEY LLP 7 TIMES SQUARE NEW YORK, NY 10036-7311			EXAMINER SIPOS, JOHN	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 09/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/040,117

Applicant(s)

AUSNIT, STEVEN

Examiner

John Sipos

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40-42 and 48-50 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40-42 and 48-50 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### ***EX PARTE QUAYLE***

The previous Ex Parte Quayle Office Action of 7/9/07 is withdrawn.

This application is in condition for allowance except for the following formal matters:

Interference.

Claims 40-42 and 48-50 are allowable. The only question to be resolved prior to allowance is the question of priority of inventorship, which is properly resolved under interference proceedings.

#### ***Interference***

Applicant has suggested an interference pursuant to 37 CFR 41.202(a) in a communication filed April 23, 2007.

1) Applicant failed to (1) identify all claims the applicant believes interfere, and/or (2) propose one or more counts, and/or (3) show how the claims correspond to one or more counts. See 37 CFR 41.202(a)(2) and MPEP § 2304.02(b). Specifically, (3) show how the claims correspond to one or more counts is deficient in the request. Applicant has submitted count 1 to be equivalent to claim 12 of US patent 6,290,391 and claim 40 of the instant application. Applicant avers claim 40 corresponds to the count as it is a copy thereof. This is taken to mean claim 40 would be anticipated by the count. Applicant continues stating that claims 41 and 42 depend from claim 40 and likewise correspond to the count. Respectfully, claim correspondence is not based upon dependency from another claim. As set forth in 37 CFR 41.207 (b) (2), A claim corresponds to a count if the subject matter of the count, treated as prior art to the claim, would have anticipated or rendered obvious the subject matter of the claim. Applicant should discuss on the record why applicant feels claims 41 and 42 fail to define a patentably distinct

invention from the count. Alternatively, applicant may admit to the record that claims 41 and 42 would be considered obvious in view of the count. Additionally, Applicant has submitted count 2 to be equivalent to claim 13 of US patent 6,347,885 and claim 48 of the instant application. Applicant avers claim 48 corresponds to the count as it is a copy thereof. This is taken to mean claim 48 would be anticipated by the count. Applicant continues stating that claims 49 and 50 depend from claim 48 and likewise correspond to the count. As outlined above, Applicant should discuss on the record why applicant feels claims 49 and 50 fail to define a patentably distinct invention from the count. Alternatively, applicant may admit to the record that claims 49 and 50 would be considered obvious in view of the count.

2) Applicant failed to provide a claim chart comparing at least one claim of each party corresponding to the count. See 37 CFR 41.202(a)(3) and MPEP § 2304.02(c). Applicant has stated that the counts and corresponding claims in the respective patents and applications are identical, that the requirements of 37 CFR 41.202(a)(3) are met. Respectfully, the rule requires a chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a). The rules provide a standardized procedure for all requests for interference. In complex interference situations where claims are not directly copied or “means + function” recitations appear in the claims, this chart is of great significance and benefit in determining applicant’s position on the interference. In situations where claims are directly copied, as herein, the rule may seem redundant; however, the rule requires applicant submit a chart.

3) Applicant failed to provide a detailed explanation as to why applicant will prevail on priority. See 37 CFR 41.202(a)(4), (a)(6), (d) and MPEP § 2304.02(c). Applicant submits in

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fulfillment of 37 CFR 41.202(a)(4), that he is the “senior party” to the proposed interference by virtue of having an effective filing date at least as early as April 15, 1999 and a foreign priority at least as early as April 20, 1998. Enablement of these dates must be provided through a combination of 37 CFR 41.202(a)(5) and 37 CFR 41.202(a)(6) which work together to establish and support such a priority claim. 37 CFR 41.202(a)(5) is meant to establish applicants ability to support the copied claims in the instant specification (*If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification*) while 37 CFR 41.202(a)(6) is where applicant establishes the enablement and entitlement to support a claim to the count through earlier priority documents. (*For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter*).

Herein, applicant has provided a chart listing the “new claims” and “support in specification”. Though no particular specification is pointed to, as this section appears submitted to fulfill the requirements of 37 CFR 41.202(a)(5) it has been presumed this specification is that of instant file 10/040117. However, this chart does not “likewise meet the requirements of 37 CFR 41.202(a)(6)” as stated by applicant in that it does not extend to show clear enablement support for each constructive reduction to practice for which applicant wishes to be accorded benefit, in particular 09/633944 and/or 09/292256 and/or the French foreign priority documents. Without such a chart establishing enablement of the scope of the interfering subject matter, the earliest date that can be accorded is the filing date of the instant invention as demonstrated in the

37 CFR 41.202(a)(5) chart thus rendering applicant as the "junior party" and 37 CFR 41.202(a)(4) not being met.

Prosecution on the merits is closed in accordance with the practice under Ex Parte Quayle, 1935 C.D. 11,453 O.G. 213.

A shortened statutory period for reply to this action is set to expire two months from the mailing date of this letter

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **571-272-4468**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at **571-272-4467**.

The **FAX** number for U.S. Patent and Trademark Office is **(571) 273-8300**.

/John Sipos/  
Primary Examiner  
Art Unit 3721